

## **Remarks**

The informality regarding the lower jacket has been corrected.

## **Obviousness**

Claims 8 and 10 were rejected on the basis of obviousness in light of Rogler 1694672 in view of Gress 4217915. Claim 9 was rejected on the basis of obviousness in light of Rogler 1694672 in view of Gress 4217915 further in light of Porter 3516420.

A showing of obviousness requires a motivation or suggestion to combine or modify prior art references, coupled with a reasonable expectation of success. The motivation and the expectation of success must be found in the prior art references. *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.* 229 F.3d 1120, 56 USPQ2d 1456, (Fed. Cir. 2000) A prima facie case of obviousness is thus a showing by the Examiner that the motivation to combine the references and a reasonable expectation of success are found in the prior art references themselves.

In *Gambro Lundia AB v. Baxter Healthcare Corp.* 42 USPQ2d 1378 (Fed. Cir. 1997). The Federal Circuit required the motivation to combine the references to be found in the prior art itself. The prior art must provide a teaching, suggestion, or some reason to make the substitution necessary to meet the claimed invention.

In *Richard Ruiz v. AB Chance Company*, the United States Court of Appeals for the Federal Circuit, stated that in making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envntl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Thus, the examiner is stating that the nature of the ceramic core reference and tongs reference inherently leads to the obvious conclusion that the combination would produce a better device.

Therefore, the applicant would like to point out some differences that are relevant. The Rogler device does not have a ceramic core and is not electrically heated. The Rogler device is made of metal and was patented long ago when ceramic cores were available. Yet, no suggestion is made that a ceramic core can be put into the Rogler device. However, because no reference has stated that a ceramic core could be used inside tong heaters for the many decades after patenting of the Rogler device, this suggest that the present invention is not in fact obvious.

Gress uses a ceramic core to distribute the heat inside an electrically heated device. The ceramic core of Gress is electrically heated unlike the present invention. The references do not show use of ceramic core on tongs that are ambient heated. Many devices use ceramic cores for distributing heat inside electrically heated elements. Gress uses ceramic core in conjunction with electrical heating and a wide variety of other elements. It does not teach use of ceramic core alone or in conjunction with a sealed metal jacket.

In *Richard Ruiz v. AB Chance Company*, the United States Court of Appeals for the Federal Circuit also stated that "the motivation to combine the teachings in the prior art may "come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem." *Pro-Mold*, 75 F.3d at 1573"

However, the nature of the references should not lend to a finding of obviousness in this particular case because Gress device is electrically heated and has a large cross section as opposed to the small cross section of the Rogler device. Thus, the references seen together do not suggest to the present invention.